

### **REMARKS**

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 12, 14-22, 29 and 30 are presently active in this case. Claims 1-11, 13, 23-28, and 31-37 have now stand canceled without prejudice or disclaimer. The present Amendment amends Claims 12, 14, 16, 17, 20-22, 29, and 30 without introducing any new matter as Claim 14 has been rewritten in independent form, Claims 12, 16, 17, 20, 21 and 29 have been amended to now depend from rewritten Claim 14, Claim 22 has been amended to incorporate the subject matter of canceled Claims 13 and that found in previously presented dependent Claim 14, Claim 20 has been rewritten in independent form and Claim 30 has been amended to correct dependency and to incorporate the changes in the Amendment under 37 CFR § 1.116 filed on June 21, 2006.

In the outstanding Office Action, it is suggested that both Claims 22 and 24 would invoke the sixth paragraph of 35 U.S.C. § 112, and Claims 30 and 34-35 were objected to because of informalities. Claims 32-34 and 36 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Claims 11, 13, 17, 21-22, 24, and 32-34 were rejected under 35 U.S.C. §103(a) as unpatentable over Bauer, II (U.S. Patent No. 3,692,394, herein "Bauer") in view of Ohshima et al. (U.S. Patent No. 4,821,911, herein "Oshima"); Claims 12 and 14-15 were rejected under 35 U.S.C. §103(a) as unpatentable over Bauer, Ohshima, Hines (U.S. Patent No. 6,122,455), and further in view of Glenn (U.S. Patent No. 4,667,226); Claims 16, 18-19 and 37 were rejected under 35 U.S.C. §103(a) as unpatentable over Bauer, Ohshima, Hines and further in view of Okada et al. (U.S. Patent No. 4,758,905, herein "Okada"); Claim 20 was rejected under 35 U.S.C. §103(a) as unpatentable over Bauer, Ohshima and further in view of Anderson (U.S. Patent No.

6,215,523); and Claims 29-31 and 35-36 were rejected under 35 U.S.C. §103(a) as unpatentable over Bauer, Ohshima and further in view of Hines.

In response to the suggestion that both Claims 22 and 24 can be said to invoke the sixth paragraph of 35 U.S.C. § 112, it is clear that only Claim 22 would do this as Claim 24 is no longer pending.

In response to the objections to dependent Claims 30, and 34-35, Claims 34-35 have been canceled to render this objection thereto moot. Claim 30 is amended to correct the noted informalities.

The rejection of Claims 32-34 and 36 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement, is also respectfully submitted to be moot as Claims 32-34 and 36 have been canceled.

In response to the rejection of Claims 11, 13, 17, 21, 22, 24, and 32-34 under 35 U.S.C. §103(a) as unpatentable over Bauer in view of Ohshima, Applicant respectfully submit that this rejection is moot as to canceled Claims 11, 13, 24, and 32-34.

With regard to the rejection of Claims 17, 21, and 22 under 35 U.S.C. §103(a) as unpatentable over Bauer in view of Ohshima, Applicant respectfully traverses the rejection of these claims as amended as they now all include the subject matter of previously presented dependent Claim 14 that was not rejected over just these two references.

Claims 12 and 14-15 were rejected under 35 U.S.C. §103(a) as unpatentable over Bauer, Ohshima, Hines, and further in view of Glenn. This rejection is traversed as to these claims as well as to the above noted Claims 17, 21, and 22.

Turning to the rationale in the outstanding rejection that was applied as to Claim 14 subject matter and Glen, the outstanding Action appears to ignore the fact that the rotating shutter 101 of Glen is taught to be between two cameras 130 and 140 that have different scan rates and not as an element that will provide a reflected portion to a view finder. Missing

from the outstanding Action is the required “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” set forth by the court in *In re Kahn*, 78 USPQ2d 1329, 1336 (Fed. Cir 2006).

In addition, the basic premise offered in support of the combination of Bauer and Ohshima is clearly flawed.

Bauer, relied upon by the outstanding Office Action as a primary reference to form the 35 U.S.C. §103(a) rejections, describes a motion picture camera, where the images are reflected by the forward surface 22 to the reflecting prism 24 and a lens system 26 to an eyepiece 28. As illustrated in Bauer’s Figure 1, the optical path is reflected twice by the rotary reflective shutter 16 and the prism 24 to get to the eyepiece 28. Therefore, Bauer ***fails to teach or suggest*** a shutter configured to direct the light to the viewfinder without further change of a viewfinder optical axis.

The outstanding Action conclude this claimed feature to be “obvious,” with no citation of evidence and no convincing line of reasoning. Instead, the outstanding Action attempts to rely on the holding in *In re Karlson*, 311 F.2d 581, 136 USPQ 184, 186 (CCPA 1963), that “omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before” (emphasis added).

Contrary to the facts presented in *Karlson*, in which certain elements and their functions are removed and all of the retained elements perform ***the same functions*** as before, Applicant’s Claim 14 includes a shutter that is configured, *inter alia*, to direct the light to the viewfinder along a viewfinder optical axis *without further change of the view finder optical axis*. In view of Applicant’s Claim 14 features, if the rationale of the *Karlson* case would be applied to the teachings of Bauer as to eliminating Bauer’s reflecting prism 24, the image reflected by the shutter 16 would have to be directly sent to the eyepiece 28, since *Karlson*

states that “the remaining elements perform the same functions as before.” This is clearly not the case, as one can see from Bauer’s Figure 1.

The advisory Action of July 19, 2006 attempts to rewrite the holding in the *Karlson* case to state that omission of an element and its function in a combination is an obvious expedient if the combination elements remaining could then be modified to perform the same functions as before. Note the unsupported conclusion offered at the end of the second paragraph on the continuation sheet that “one of ordinary skill in the art could have easily modified Bauer to be constructed without the prism.” The PPTO reviewing court has often pointed out to the PTO that the question of obviousness cannot be settled by unsupported conclusions as to what the artisan “could” have done. See *In re Mills*, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) and *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Int. 1993).

The PTO reviewing authority has held that the omission of an element and the retention of its function is an indicia of unobviousness. *In re Edge*, 359 F.2d 896, 899, 149 USPQ 556, 557 (CCPA 1966), and the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992). In addition, such an omission of Bauer’s reflecting prism 24 would require a substantial reconstruction or redesign of the mechanical and optical elements of Bauer. There is no evidence that a person of ordinary skill in the art would be motivated to perform such changes and redesign.<sup>1</sup>

The remaining applied references Ohshima, Hines, Glen (noted above), and Okada also fail to teach or suggest Applicant’s claimed feature regarding a shutter configured to direct the light to the viewfinder without further change of a viewfinder optical axis. While

---

<sup>1</sup> See *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (reversing an obviousness rejection where the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.”)

Ohshima and Glenn do not disclose viewfinders, Hines' viewfinder is arranged separate from the main optical axis and Okada's system includes an electronic viewfinder 61 that gets the image from the image sensor 23.<sup>2</sup> Accordingly, the remaining references, taken individually or in combination, also fail to teach or suggest all the features of Applicant's claims and therefore Applicant traverses the rejection of independent Claim 14 and request reconsideration of the rejection.

Since independent Claims 20 and 22 recite analogous features to those recited by Claim 14 in the context of a means-plus-function claim (Claim 22) and a further apparatus claim adding a "screen configured to display the synthesis of the light components after passage into processing means" (Claim 20), the rejection of independent Claims 20 and 22 under 35 U.S.C. §103(a) is also believed to be overcome.

In addition, it is believed to be clear that the feature added by Claim 20 ("a screen configured to display the synthesis of the light components after passage into processing means") is not taught or suggested by any of the references being relied upon. Accordingly, Claim 20 is further submitted to be patentable for this reason as well.

Regarding Applicant's dependent claims, since the independent Claims 14, 20 and 22 are believed to be allowable, the claims dependent thereon are also believed to be allowable.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance.

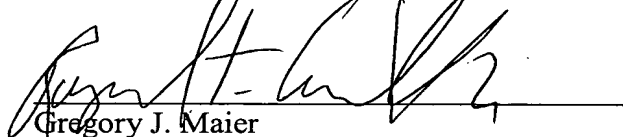
---

<sup>2</sup> See Hines in Figure 12 and 13.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Gregory J. Maier  
Attorney of Record  
Registration No. 25,599

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 06/04)

Raymond F. Cardillo, Jr.  
Registration No. 40,440

I:\ATTY\NS\000154\204252US\204252US.AM2-DRAFT1.DOC